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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,042	02/10/2004	John Edward Fox	12742.8USC1	2121

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EXAMINER	
PRINCE, FRED G	
ART UNIT	PAPER NUMBER
1724	

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,042

Applicant(s)

FOX ET AL.

Examiner

Fred Prince

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0504, 0804.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14, 38, 40, 42, and 43 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No. 6,692,637. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the patent may be construed broadly enough to fully encompass the subject matter called for in the instant claims.

3. Claims 15-37, 39, 41, and 44-62 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,692,637 ('637) in view of Willinger et al. ('125).

The '637 patent does not claim a replaceable filter cartridge including non-permanently attached porous walls.

Willinger et al. disclose making a filter cartridge that is replaceable and includes non-permanently attached porous walls in order to, for example, reuse the frame providing the surface for biological growth (abstract; col. 6, lines 54-59) and dispose of the walls after they become fouled (col. 5, lines 15-18).

It would have been readily obvious for the skilled artisan to have provided a replaceable filter cartridge in order to, for example, reuse the frame providing the surface for biological growth and dispose of the walls after they become fouled.

The '637 patent does not claim a clip that snaps over flaps of the frame.

Willinger et al. disclose a providing a clip (12) in order to, for example, bias the flaps to hold the porous walls closed and sealed (col. 6, lines 16-18).

It would have been readily obvious for the skilled artisan to provide a clip (12) to the claimed filter cartridge in order to, for example, bias the flaps to hold the porous walls closed and sealed.

The '637 patent does not claim a frame having the instantly recited structure.

Willinger et al. disclose providing a frame (2,4,5,6, 9; Fig. 3) with the recited structure in order to, for example, provide a structure suitable for the growth, settlement, and propagation of bacteria (col. 2, lines 21-22) while providing stability to the porous walls (col. 2, lines 30-33).

It would have been readily obvious for the skilled artisan to provide a frame with the recited structure in order to, for example, provide a structure suitable for the growth, settlement, and propagation of bacteria while providing stability to the porous walls.

The '637 patent does not claim activated carbon treatment prior to biological treatment.

Willinger et al. disclose activated carbon (13) treatment prior to biological treatment (col. 2, lines 38-48; col. 5, lines 4-11 and 22-29) in order to, for example, synergistically filter contaminants out of the water.

It would have been readily obvious for the skilled artisan to provide activated carbon treatment prior to biological treatment in order to, for example, synergistically filter contaminants out of the water.

The '637 patent does not claim a non-cylindrical construction having porous walls with a longitudinal dimension greater than a transverse dimension.

Willinger et al. discloses a rectangular, non-cylindrical construction (col. 8, lines 1-7) having porous walls with a longitudinal dimension greater than a transverse dimension (Fig. 3; col. 4, line 15) in order to, for instance, separate a front chamber from a rear chamber of a rectangular housing (72; col. 8, lines 31-38).

It would have been readily obvious for the skilled artisan to provide a rectangular, non-cylindrical construction having porous walls with a longitudinal dimension greater than a transverse dimension in order to, for instance, separate a front chamber from a rear chamber of a rectangular housing.

Information Disclosure Statement

4. The information disclosure statements filed on May 10, 2004 and August 9, 2004, respectively, fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that

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portion which caused it to be listed; and all other information or that portion which caused it to be listed. The statements have been placed in the application file, but Exhibits A, C, and D referred to therein have not been considered. Copies of publications listed as Exhibits A, C, and D have not been received by the Office. Further, it is noted that a publication entitled "Renaissance Prime 10/20/30 Self-Priming Canister Filters" has been received but is not listed on an IDS.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-16, 19-20, 22-27, and 44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hashimoto et al.

Hashimoto et al. teaches a first porous filter wall (8a) having a first density (col. 5, lines 45-48) and a second porous filter wall (8b) having a second density (col. 5, lines 49-51) different from that of the first density, the walls interconnected to each other to

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define an interior volume and positioned in parallel (Figures), a frame (10) maintaining the relative positions of the first and second walls.

Regarding the preamble recitation that the filter is a water filter for aquarium water, it is submitted the recitation is one of intended use which fails to add structure to the filter and is not give patentable weight. If it is applicant's position that the recitation adds structure, it is submitted that filter article is capable of filtering water, including aquarium water.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References are cited of interest to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Prince whose telephone number is (571) 272-1165. The examiner can normally be reached on Monday-Thursday, 6:30-4:00; alt. Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fred Prince
Primary Examiner
Art Unit 1724

fgp
3/9/05